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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/602,105	06/22/2000	Dennis P. Curran	00-012	8803

7590

07/22/2002

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EXAMINER

NAZARIO GONZALEZ, PORFIRIO

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 07/22/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/602,105

Applicant(s)

CURRAN ET AL.

Examiner

Porfirio Nazario-Gonzalez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. In view of Applicants' amendment to claims 6 and 15, filed April 3, 2002, the rejection under 35 U.S.C. 112, second paragraph is withdrawn.

Response to Arguments

2. Applicant's arguments filed April 3, 2002 traversing the rejection of claims 1-16 under 35 U.S.C. 102(b) as anticipated by Curran et al. have been fully considered but they are persuasive.

3. Applicant's arguments filed April 3, 2002 traversing the rejection of claims 10-12, 16, 19 and 20 under 35 U.S.C. 102(b) as anticipated by U.S. Pat. 3,590,060 have been fully considered but they are not persuasive. Applicants argued that the trifluoropropyl groups disclosed in the '060 "do not contain sufficient fluorine atoms to cause the compounds thereof to partition sufficiently preferentially into a fluorous phase to achieve an effective fluorous-organic phase separation." The Examiner respectfully disagrees. The broad terms "fluorocarbon" or "perfluoroalkyl" in the instant claims for the variable "Rf" read on the group CF₃. Furthermore, the claims do not recite any limitations as to partition properties of these groups. Therefore, the compounds disclosed by the '060 patent read on the instant claims. Thus, the rejection of the claims stand.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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5. Claims 1-16 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Curran et al., J. Am. Chem. Soc., Vol. 121, pp. 6607-6615 (Published on the Web 07/02/1999). Curran et al. discloses a tin hydride of the formula $[Rf-(CH_2)_n]Me_2SnH$ where Rf is a C_4-C_{10} perfluorocarbon and n is 2 or 3. Note that the inventive entity of the Curran et al. reference is different from the instant application.

Allowable Subject Matter

6. The indicated allowability of claims 17 and 18 is withdrawn in view of the newly discovered reference(s) to Bucher et al., Tetrahedron Letters, Vol. 41, pp. 9617-9621 (Published December 2, 2000. Rejections based on the newly cited reference(s) follow.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

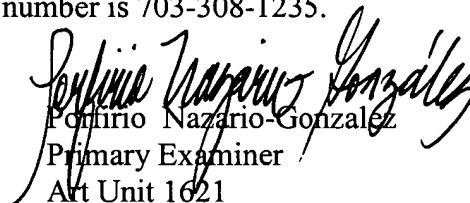
8. Claims 17 and 18 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The inventive entity, Brian Bucher and Dennis P. Curran, in the Tetrahedron Letters reference is different from the inventive entity of the instant application, Dennis P. Curran and Zhiyong Luo. Further note that the reference discloses the compound of the formula $(C_6F_{13}CH_2CH_2)_2SnO$ which reads on the instant claims. Thus, the reference raises a question as to who is the inventive entity.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Porfirio Nazario-Gonzalez whose telephone number is 703-308-4632. The examiner can normally be reached on Mon.-Thur. (7:30 AM - 6:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Porfirio Nazario-Gonzalez
Primary Examiner
Art Unit 1621

PNG

July 17, 2002